

Applicant: Herbert Wehler
Application No.: 10/571,880

Remarks

Claims 1 and 14 to 22 are pending in this application, and all have been rejected for the reasons discussed below.

Information Disclosure Statement

The examiner states that "the information disclosure statement filed March 4, 2009 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information regarding German Patent Publication DE 198 06 762 to therein has not been considered." Applicants note that U.S. Patent 6,152,519 was submitted on March 4, 2009, is an English language equivalent of DE 198 06 762, and was considered by the examiner on October 21, 2009. Nonetheless, Applicant was able to obtain a translation of the German Publication and includes it herewith in an Information Disclosure Statement.

Amendment to Claims 15 and 20

Claim 15 is amended to delete "closer together" and is replaced by - - spaced apart a first distance- -: Also, after "open position" - - and are spaced apart a second distance when the sliding door is in the closed position, and the first distance is smaller than the second distance - - was added.

Claim 20 is amended to delete "is closer to the sliding door" and is replaced by - - has a length that is shorter - -. Also, after "than" the word "the" was deleted and - - a length of the - - as added.

Amendment to the Abstract

The Abstract is amended to delete "is described" in the first line.

Objection to Previous Amendment

Applicant's March 4, 2009 amendment was objected to for adding new matter. The partial sentence, "the first section is close to the sliding door than the second section as set forth in claim 20," is thought by the examiner to be new matter. Applicant respectfully disagrees because the drawings support this statement.

Claim 20, in which the objected to phrase was added, is amended to read as follows:

20. The sliding door system of claim 1, wherein the energy guide chain further comprises:

a first section in which the first radius of curvature is formed when the sliding door is in the closed position; and

a second section in which the second radius of curvature is formed when the sliding door is in the open position, and

wherein the first section is closer to the sliding door than the second section.

(Emphasis added.)

This amendment avoids the use of the objectionable language and now recites that the first section has a length that is shorter than a length of the second section. This relative relationship is apparent by comparing Fig. 1 to Fig. 3. The length of energy guide chain in the curved portion in Fig. 1 is shorter than the portion in Fig. 3. Thus, Applicants respectfully submit that this amendment traverses the new matter objection and accurately claims the invention.

Claim Rejection Under 35 U.S.C. §112

Claim 15 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention because the term “closer” was recited without a reference distance. The above amendment to claim 15 traverses this rejection because it defines first and second distances and their respective sizes.

Claim Rejection Under 35 U.S.C. §102

Claims 1, 14, 19 and 22 are rejected under 35 U.S.C. §102(e) as being anticipated by *Suzuki*, U.S. Patent 6,787,702. Claims 1, 14, 15, and 19 to 22 are rejected under 35 U.S.C. §102(e) as being anticipated by *Kobayashi et al.*, U.S. Publication 2004/003543. To maintain a rejection under 35 U.S.C. §102(b), all of the elements of each claim must be disclosed in a single reference. The test for anticipation requires a strict, not substantial, identity of corresponding claim elements. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334-35, 2008 U.S. Appl. LEXIS 8404, 27-28 (Fed. Cir. 2008).

Claims 1 and 22 are independent claims and claims 1, 14, 15, and 19 to 21 depend from claim 1. As explained below, claim 1 is not anticipated by the art of record and, therefore, dependent claims 14 and 15 are also not anticipated.

Concerning the disclosure of *Suzuki*, Applicant respectfully disagrees with the examiner's interpretation. This document does not show that the energy chain is connected to the sliding door. Fig. 1 shows that one end of the energy chain is connected to the car body. Further, Figs. 5 and 6 show a “slack-absorbing device,” (item 24 in Figs. 1 to 3, 5, 6, 11 and 17, and item 24' in Figs. 7 and 8) into which wires are coiled. The device has a wheel that is rotatable in a storage case. The wires are rolled around the wheel, and are not connected as recited in the claims.

The armoring member 1 does not appear to be connected to the sliding door. Instead, the armoring member 1 is supported by the wires 5. In contrast, claim 1 requires the energy guide chain to be connected to the door.

Furthermore, Fig. 1 shows that the energy chain has a first section (21) and a second section (20). The first section bends in the left direction, the second section bends in the right direction, but does not bend in the left direction as shown at Figs. 1 and 2.

Concerning the *Kobayashi et al.* disclosure, Figs. 12 and 1 as well as Fig. 2 shows clearly that the energy chain has a constant radius of curvature. Thus, the recitations of independent claims 1 and 22 of an energy guide chain having different radii of curvature are not anticipated or rendered obvious by *Kobayashi et al.* because there is no strict correspondence of elements with the independent claims.

Claim Rejection Under 35 U.S.C. §103

Claims 16 to 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Suzuki* as applied to claims 1, 14, 19 and 22.

The Standard for Prima Facie Obviousness

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skills in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, *the prior art reference must teach or suggest all the claim limitations. In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (Emphasis added). See M.P.E.P. §2143.

Obviousness is not to be read into an invention on the basis of the Applicant's own statements; that is, the prior art must be viewed without reading into that art Applicant's

Applicant: Herbert Wehler
Application No.: 10/571,880

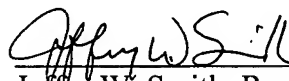
teachings. *In re Murray*, 268 F. 2d 226, 46 CCPA 905; *In re Sporck*, 301 F.2d 686, 49 CCPA 1039. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of Applicant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 395 F.2d 801, 55 CCPA 1198.

For the reasons stated above, regarding how *Suzuki* and *Kobayashi et al.* do not anticipate the claims, and they also do not render the claims obvious because they are lacking elements recited in claim 1 from which claims 16 to 18 depend. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). See M.P.E.P. §2143.

Conclusion

For the foregoing reasons, Applicant respectfully submits that the pending claims are allowable and request that this case be passed to issue.

Respectfully submitted,



Jeffrey W. Smith, Reg. No. 33455
Attorney for Applicant
SMITH LAW OFFICE
8000 Excelsior Drive, Suite 301
Madison, WI 53717
(608) 824-8300